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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,420	07/09/2003	Ilkka Westman	059643.00260	7974
32294 7590 01/23/2008 SQUIRE, SANDERS & DEMPSEY L.L.P. 14TH FLOOR 8000 TOWERS CRESCENT TYSONS CORNER, VA 22182			EXAMINER FRINK, JOHN MOORE	
			ART UNIT 2142	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/615,420

**Applicant(s)**

WESTMAN ET AL.

**Examiner**

John M. Frink

**Art Unit**

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 5, 7 - 29, 31 - 39 and 41 - 48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 5, 7 - 29, 31 - 39 and 41 - 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 3 - 6, 7, 8, 14, 16, 17, 20, 24 - 29, 36 - 39, 42, 44, 45, 46, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over as TS 24.229 version 5.3.0 Release 5, hereafter referred to as 229, in view of 3GPP 23.218 version 5.3.0 Release 5, hereafter referred to as 218.
2. Regarding claim 1, 229 shows a service provisioning method in a communication system, including a first entity associated with a communication system (represented by the S-CSCF; Section 5.7.3), a storage entity (represented by the HSS, Section 5.7.3) and a communication control entity configured to service a user (represented by the AS, Section 5.7.3), as well as where initiating requests can be originating or terminating (Section 5.4.3).

229 does not show receiving at the first entity associated with a communication system from a storage entity, information comprising an address or a name of a communication control entity configured to service a user of the communication system, and generating, by the first entity, an initial request on behalf of the user, and based on said information, signaling the initial request from the first entity to the communications control entity, wherein the initial request includes information regarding the handling of

communications associated with the request, the information in the initial request indicating whether to originate or terminate a service.

218 shows receiving at the first entity associated with a communication system (S-CSCF) from a storage entity (HSS), information comprising an address or a name of a communication control entity configured to service a user of the communication system (AS, pg. 12 bottom 1/3 of page), and

generating, by the first entity, an initial request on behalf of the user (where said S-CSCF generates a REGISTER message, Fig. 6.3.1 and Section 6.3), and

based on said information, signaling the initial request from the first entity (S-CSCF) to the communications control entity (AS, Section 6.3 and Fig. 6.3.1, specifically Section 6.3 paragraph 4, lines 4-5 where the REGISTER request body is generated by the S-CSCF based on a REGISTER request it has received, which is further updated by information retrieved from the HSS),

wherein the initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service (where the S-CSCF checks trigger points to determine if it is an originating request or a terminating request, Section 6.4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of 229 with that of 218 because 229 and 218 are both technical specifications produced by the same organization for the common purpose of elaborating the developing 3GPP standard and the information contained within 218 and 229 is intended to be used together.

3. Regarding claim 3, 229 in view of 218 further shows where the initial request includes an indication that further communications associated with the initial request shall be handled in a similar manner as though the request had originated from the user (229, Section 5.7.3, and 218, Section 6.4).
4. Regarding claim 4, 229 in view of 218 further shows where either terminating services or originating services are provided based on the request (218, Sections 6.4 and 6.5).
5. Regarding claim 5, 229 in view of 218 further show deciding in the first entity how the communication control entity shall handle further communications associated with the request (218 Section 9.1 pages 24 – 27).
6. Regarding claim 7, 229 shows where the initial request is generated based on information regarding an address of the communication control entity (Section 5.7.3).
7. Regarding claim 8, 229 shows where the first entity modifies said information regarding the address of the communication control entity before sending the initial request (Section 5.7.3).
8. Regarding claim 14, 229 shows where the information received from the storage entity comprises an Universal Resource Identifier (URI) of the communication control entity (Section 5.7.3), where the address corresponds to said URI.
9. Regarding claim 16, 229 in view of 218 further show where the information received from the storage entity comprises a service type indicator parameter (218 Sections 6.3 and 6.4).

10. Regarding claim 17, 229 shows sending an enquiry to a database from the first entity before sending of the initial request, said enquiry being based on the information regarding the communication control entity (Section 5.7.3).

11. Regarding claim 20, 229 shows sending an enquiry from the first entity for said information regarding the communication control entity capable of servicing the user (Section 5.7.3).

12. Regarding claim 24, 229 shows where the initial request is indicative of filter criteria to be applied to the request (Sections 5.4.3.1 and 5.7.3).

13. Regarding claim 25, 229 shows where the first entity comprises an application server (Section 5.7.3).

14. Regarding claim 26, 229 shows where the communication control entity comprises a serving call session control function (Section 5.7.3).

15. Regarding claim 27, 229 shows where the storage entity comprises a user information storage entity (Section 5.7.3).

16. Regarding claim 28, 229 shows where the user information storage entity is one of a home subscriber server, a subscriber location function, a service and a Subscription repository (Section 5.7.3).

17. Regarding claim 29, 229 in view of 218 show a communication system comprising a communication control entity configured to service a user of a communication system (218, pg. 12 and 229, Section 5.7.3), and

a first entity provided with a first interface configured to receive information from a storage entity comprising an address or name of the communications control entity

and a second interface configured to signal an initial request to the communications control entity based on said information from the storage entity (218, Sections 6.3, Fig. 6.3.1),

wherein the first entity is configured to generate the initial request on behalf of the user (218, Section 6.3) and

wherein the initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service (218, Section 6.4).

18. Regarding claims 36 and 45, 229 shows where the initial request is indicative of filter criteria to be applied to the request (Section 5.7.3).

19. Regarding claim 37, 229 in view of 218 show an application server (represented by said AS) comprising a first interface to receive information from a storage entity regarding a user of the communication system (229, Section 5.7.3 and 218, Section 6.3)

a second interface configured to signal an initial request to the communications control entity based on said information from the storage entity (218, Sections 6.3, Fig. 6.3.1), the information comprising an address or a name of the communication control entity (218, pg. 12)

wherein the initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service (218, Section 6.4).

20. Regarding claim 38, 229 in view of 218 further show an originating initial request to be signaled on an interface between a first entity of a communications system and a

communication control entity configured to service a user of the communication system, the initial request being generated based on information from a user information storage entity, wherein the information comprises an address of or a name of the communication control entity, wherein the initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service (229, Section 5.7.3, and 218, Sections 6.3 – 6.4).

21. Regarding claim 39, 229 in view of 218 show receiving means for receiving at a first entity associated with a communication system (S-CSCF) from a storage entity (HSS), information comprising an address or a name of a communication control entity configured to service a user of the communication system (218, AS, pg. 12 bottom 1/3 of page), and

signaling means for signaling the initial request from the first entity (S-CSCF) to the communications control entity based on said information (218, AS, Section 6.3 and Fig. 6.3.1, specifically Section 6.3 paragraph 4, lines 4-5 where the REGISTER request body is generated by the S-CSCF based on a REGISTER request it has received, which is further updated by information retrieved from the HSS),

wherein the network is entity is configured to generate the initial request on behalf of the user (218, Sections 6.3 and 6.4)

wherein the initial request includes information regarding the handling of communications associated with the request, the information in the initial request

indicating whether to originate or terminate a service (where the S-CSCF checks trigger points to determine if it is an originating request or a terminating request, Section 6.4).

22. Regarding claim 42, 229 in view of 218 shows where the sending means is configured to send the enquiry before the initial request is sent, and said enquiry being based on the information regarding the communication control entity (229 Section 5.7.3 and 218, Section 6.3-6.4).

23. Regarding claim 44, 229 shows where wherein information regarding at least two different addresses for the communication control entity information is stored in the storage entity (Section 5.7.3).

24. Regarding claim 45, 229 shows where the initial request is indicative of filter criteria to be applied to the request (Sections 5.4.3.1 and 5.7.3).

25. Regarding claim 46, 229 in view of 218 further show a network entity comprising a first interface configured to receive information from a storage entity comprising an address of or a name of a communication control entity configured to service the user based on said information from the storage entity (218, Section 6.3 and 229 Section 5.7.3) and

a second interface configured to signal an initial request to the communication control entity (218 Fig. 5.2.1 and Fig. 6.3.1)

wherein the network entity is configured to generate an initial request on behalf of the user (218 Section 6.3.1) and

wherein the initial request includes information regarding the handling of

communications associated with the request, the information in the initial request indicating whether to originate or terminate a service (218, Section 6.4).

26. Regarding claim 47, 229 in view of 218 further show wherein the network entity comprises at least one of a gateway, a server a proxy, a client or a user agent (229, Section 5.7.3; 218, Section 5.2 pages 12 - 13, Section 6.3 pages 15 – 16).

27. Regarding claim 48, 229 in view of 218 further show a storage entity, comprising two stored addresses of a communication control entity, an address for an originating role, and an address for a terminating role, wherein the storage entity is configured to send one or both of the two stored addresses to an application server on request for use in generating an initiating request on behalf of the user and, wherein the initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate a service (218, Section 6.4 and 229, Section 5.7.3; 218, Section 5.2 pages 12 - 13, Section 6.3 pages 15 – 16).

28. Claims 9, 10, 13, 21, 22, 23, 31, 32, 35, 41 and 44 rejected under 35 U.S.C. 103(a) as being unpatentable over 229 in view of 218 as applied to claim 1 above, further in view of Kauppinen et al. (WO 02/09365 A1), hereafter referred to as WO.

29. Regarding claim 9, 229 in view of 218 disclose the method of claim 1.

229 in view of 218 do not disclose adding, by the first entity, a service type indicating into the initial request.

WO discloses adding, by the first entity, a service type indicating into the originating request. (pg. 15, line 18 – pg. 16 line 16), where a flag included in the request is used to indicate the service type.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of 229 in view of 218 with that of WO as both 229 in view of 218 and WO detail communication methods involving setup between a user and various Call State Control Function (CSCF) systems and a Home Subscriber Server (HSS), where WO enables simplifying the communications network which both WO and 229 in view of 218 utilize.

30. Regarding claim 10, 229 in view of 218 and WO further disclose where service type indicator is included in an address of the communication control entity, specifically where WO col. 20 line 20 – col. 21 line 12 shows where the address itself serves as the service type indicator, and alternatively, WO pg. 19 line 8 – pg. 20 line 7 shows where the port number serves as the service type indicator.

31. Regarding claim 13, 229 in view of 218 and WO further disclose selecting, by the a port where the request shall be sent (WO pg. 18 line 27 – pg. 19 line 20, pg. 25, lines 24 – 30, pg. 26 lines 20 – 30).

32. Regarding claims 21 and 35, 229 in view of 218 and WO further disclose where information regarding at least two different addresses for the communication control entity information is stored in the storage entity (pg. 20 line 21 – pg. 21 line 12).

33. Regarding claim 22, 229 in view of 218 and WO further disclose at least two different addresses are fetched from the storage entity by the first entity before sending

of said request, specifically where the HSS corresponds to the storage entity, which contains two address, one for an I-CSCF and one for an S-CSCF (WO pg. 20 line 21 – pg. 21 line 12).

34. Regarding claim 23, 229 in view of 218 and WO further disclose fetching one of at least two different addresses from the storage entity by the first entity before sending of said request (WO pg. 20 line 21 – pg. 21 line 12).

35. Regarding claim 31, 229 in view of 218 and WO further disclose where the origination request signaled on the interface between the first entity and the communication control entity includes a service type indicator (pg. 15, line 18 – pg. 16 line 16), where a flag included in the request is used to indicate the service type.

36. Regarding claim 32, 229 in view of 218 and WO further disclose specifically where WO col. 20 line 20 – col. 21 line 12 shows where the address itself serves as the service type indicator, and alternatively, WO pg. 19 line 8 – pg. 20 line 7 shows where the port number serves as the service type indicator.

37. Regarding claim 35, 229 in view of 218 and WO further disclose where the storage entity is configured to store information regarding at least two different addresses for the communication control entity (pg. 20 line 21 – pg. 21 line 12).

38. Regarding claim 41, 229 in view of 218 and WO further disclose where the information received from the storage entity comprises a service type indicator parameter. (pg. 15, line 18 – pg. 16 line 16), where a flag included in the request is used to indicate the service type.

39. Regarding claim 44, 229 in view of 218 and WO further disclose where information regarding at least two different addresses for the communication control entity information is stored in the storage entity (WO pg. 20 line 21 – pg. 21 line 12).

40. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over 229 in view of 218 and WO as applied to claim 10 above, and further in view of Banerjee (US 2003/0053441 A1).

229 in view of 218 and WO shows claim 10.

229 in view of 218 and WO do not show where the service type indicator is included in a user part or domain part of the address.

Banerjee shows how the entire address, including the user and domain part determines where the request is routed (Banerjee [0008]), which determines the service type (WO; pg. 20 line 21 – pg. 21 line 11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of 229 in view of 218 and WO with that of Banerjee as the Internet Protocol address system, including the user and domain parts of the address, was designed to be used in its entirety to determine how to handle messages.

41. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over 229 in view of 218, as applied to claim 1 above, further in view of Foti et al. (US 2002/0027915 A1).

229 in view of 218 show the method of claim 1.

229 in view of 218 do not show where the information received from the storage entity comprises a name of the communication control entity.

Foti et al. shows the information received from the storage entity comprises a name of the communication control entity (Fig. 1A, 1B, [0022]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of 229 in view of 218 with that of Foti et al. in order to utilize a standard and common method that utilizes an easy-to-remember and enter key (in this case, the name) in order to connect to a remote device.

42. Claims 18 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over 229 in view of 218 as applied to claim 1 above, further in view of RFC 2782 (<http://tools.ietf.org/html/rfc2782>).

229 in view of 218 show the method of claim 1 and 17.

229 in view of 218 do not show where the first entity enquires for SRV records of a Domain Name system for obtaining routing information regarding a desired service.

RFC 2782 shows where the first entity enquires for SRV records of a Domain Name system for obtaining routing information regarding a desired service (pg. 1, 'Overview and rationale' section).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of 229 in view of 218 with that of RFC 2782 in order to utilize RFC 2782 for the purpose for which it was created; to illustrate a standardized method of utilizing DNS SRV.

43. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over 229 in view of 218 as applied to claim 1 above, further in view of RFC 2168 (<http://tools.ietf.org/html/rfc2168>).

229 in view of 218 show the method of claim 1.

229 in view of 218 do not show where the first entity enquires for Naming Authority Pointer (NAPTR) resource records to find out available services.

RFC 2168 show the first entity enquires for Naming Authority Pointer (NAPTR) resource records to find out available services (pg. 1, Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of 229 in view of 218 with that of RFC 2168 in order to utilize RFC 2782 for the purpose for which it was created; to illustrate a standardized method of utilizing the NAPTR.

44. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over 229 in view of 218 as applied to claims 1 and 29 above, further in view of Faccin et al. (US 2001/0049790 A1).

229 in view of 218 show the method of claim 29.

229 in view of 218 do not show where the database comprises a Domain Name system.

Faccin et al. shows a database for storing service related information, specifically where the database comprises a Domain Name system (Fig. 1, [0027]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of 229 in view of 218 with that of Faccin et al. in order to utilize a common standardized method of storing and retrieving system related information, specifically the Domain name system.

***Response to Arguments***

1. Applicant's arguments filed 11/14/2007 have been fully considered but they are not persuasive. After summarizing the claims, Applicant argues that the 229 in view of 218 do not show the claimed subject matter because the current claims are concerned with "sending an initial request from another entity than the user equipment". However, this exact language is not claimed. Furthermore, the existing claim language, regarding a first entity generating an initial request on behalf of the user, is clearly shown, as outlined in the above rejections (specifically the rejection of independent claim 1). Additionally, Applicant notes that said initial request must be "on behalf of a user"; this language is claimed, and is clearly shown in the cited art (see 218, Sections 6.3 and 6.4, specifically section 6.3.1; for further details see the above rejections). Therefore, Applicant's arguments are not persuasive.
2. Applicant also argues that the 218 reference only discloses 'when the initial request comes from the user equipment'. However, specific claim language explicitly stating that the claimed initial request should not come from user equipment is not in the current claims. Rather, the Applicant merely claims that an 'initial request on behalf of the user' be generated by 'a first entity associated with a communication system.' Applicant's arguments therefore are not persuasive.
3. Applicant next argues that, in Applicant's opinion, certain problems may occur implementing the methods shown in the cited art relating to 'wherein the initial request includes information regarding the handling of communications associated with the request, the information in the initial request indicating whether to originate or terminate

a service'. However, Applicant is only addressing the 229 reference, where the rejection was made under 35 USC 103, 229 in view of 218. Furthermore, in response to applicant's argument that the references fail to show certain features of Applicant's invention, Applicant is reminded that while the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

4. Applicant next argues that the dependent claims are allowable for the reasons addressed above. This is not persuasive as Applicant's previous arguments were not persuasive.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Frink whose telephone number is (571) 272-9686. The examiner can normally be reached on M-F 7:30AM - 5:00PM EST; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SUPERVISORY PATENT EXAMINER